

## II. Remarks.

The Official Action has been carefully considered. This Response is believed sufficient to place the present application in condition for allowance. Reconsideration is therefore respectfully requested.

Claims 1-5, 8-12, 14, 16, 17, 26, 27, 29, 31 and 33 remain pending in the application, claims 1-5, 8-11, 14, 16, 17, 26, 27, 29, 31 and 33 are hereby amended, and claims 6, 7, 13, 15, 18-25, 28, 30, and 35 are canceled.

Claim 1 is objected to because "mechanism9" should be "mechanism," and "arranged, to" should be "arranged to". Claim 1 has been amended accordingly.

Claim 5 is objected to because the claim is missing a period after the word users. Claim 5 has been amended accordingly.

Claim 6 is objected to because there is a dash after the period. Claim 6 has been canceled.

Claim 11 is objected to because the claim is missing a period after the word users. Claim 11 has been amended accordingly.

Claim 26 is objected to because "sum certain" should be "certain sum". Claim 26 has been amended accordingly.

As the above amendments correct minor informalities, it is believed that no new matter has been added by these amendments.

### 35 U.S.C. §112

**Claims 1-33** are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**As per claims 1-33,** the Examiner asserts that "claim submission mechanism," "registration mechanism," and "claims processing mechanism" are vague and indefinite because it is unclear what Applicant intends the term "mechanism" to cover (i.e., whether "mechanism" is software or hardware). The claims as currently amended clearly indicate that claims reciting the term "mechanism" contemplate software. For example, claim 1 has been amended such that the "claim submission mechanism," "registration mechanism," and "claims processing mechanism" are components of a set of executable instructions tangibly embodied on computer readable

medium. Similarly, claim 10 has been amended to provide for a computer-implemented method in which the various "mechanisms" are stored on a computer readable medium. Support for these amendments may be found at [0004] as well as original claims 17, 30, and 32. It is believed that no new matter has been added by the amendments.

**As per claims 5, 6, 13-14, 16-17, 20 24, and 32,** the Examiner asserts that it is not clear whether or not the claim is referring to two elements in the alternative or whether the claim requires both of the elements encompassed by "and/or" and therefore the claims are vague and indefinite. The presently pending claims cited above have been amended and no longer recite "and/or." Rather, the amended claims positively recite that the elements may be an individual element or a combination of elements. It is believed that no new matter has been added by the amendments.

**As per claims 18-19, 21, 26-27, 29-31 and 33,** the Examiner asserts that the written description fails to disclose the corresponding structure, material, or acts for the claimed invention as the claims recite "means for" claim elements which are mean plus function limitations that invoke 35 U.S.C. §112, sixth paragraph. The presently pending claims cited above have been amended such that they no longer include means plus function limitations under 35 U.S.C. §112, sixth paragraph. It is believed that no new matter has been added by the amendments.

**As per claims 22-29,** the Examiner asserts that the structure of the "apparatus" claims are unclear, and that the Examiner interprets "apparatus" to mean any apparatus. Claims 22-25, and 28 have been canceled. Claims 26, 27, and 29 have been amended to recite a program product rather than an apparatus. Support for these amendments may be found at [0004] as well as original claims 17, 30, and 32. It is believed that no new matter has been added by the amendments.

The foregoing is believed to be a comprehensive and effective response to the rejections under 35 U.S.C. §112 set forth in the most recent Office Action. The application is therefore believed to be in condition for allowance and an early allowance is respectfully requested.

## 35 U.S.C. §101

**Claims 1-33** are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

**As per claim 1-9**, the Examiner asserts that the claims are directed to a system but the components are all software elements, and no computer-readable medium or other hardware is positively recited to establish a statutory category or enable any functionality of the recited descriptive material to be realized. Claim 1 has been amended to recite a system comprising a processor and a computer readable medium tangibly embodying a set of executable instructions. The set of executable instructions comprises a "registration mechanism," a "claim submission mechanism," and a "claim processing mechanism" that, when executed, cause the processor to take particular actions. Support for these amendments may be found at [0004] as well as original claims 6, 7, 17, 30, and 32. It is believed that no new matter has been added by the amendments. The Applicant submits that the amendments to claims 1-9 overcome the rejection under 35 U.S.C. §101. Reconsideration is respectfully requested.

**As per claims 10-16**, the Examiner asserts that claim 10 is directed to a method that comprises steps that are not tied to a machine or apparatus and do not involve transforming an article into a different state or thing and therefore fails the "machine or transformation test" of *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008). Claim 10 has been amended to be directed to a computer-implemented method that is performed by a "registration mechanism," a "claim submission mechanism," and a "claim processing mechanism" that are stored on a computer readable medium. Therefore, claim 10, as well as claims 11-16 depending therefrom, are tied to a particular machine. Additionally, currently amended claim 10 includes a limitation that requires "generating and transmitting a message such that funds are transferred from a funded account to a provider account...." Funds, funded accounts and provider accounts are physical articles that may be represented in various forms (e.g., funds may be paper money, coin money, or also electronic, and funded and provider accounts may be vault holding paper money, coin money or may also be electronic, for example). Claim 10 provides for a physical change to the funded account and the provider account as well as the funds because funds are transferred from one account to another, thereby decreasing the value of the funded account and increasing the value of the provider account accordingly. Therefore, amended claim 10, as well as claims 11-16 depending therefrom, meet the "machine or transformation test" as required by *In re Bilski*.

Support for these amendments may be found at [0004] as well as original claims 13, 15, 17, 30, and 32. It is believed that no new matter has been added by the amendments. The Applicant submits that the amendments to claims 10-16 overcome the rejection under 35 U.S.C. §101. Reconsideration is respectfully requested.

**As per claims 22 and 26** (as well as claims 22-25 and 27-29 depending from either claim 22 or claim 26), the Examiner asserts that the claims recite an apparatus but the structure of the apparatus are merely software elements. Claims 22-25 have been canceled. Claims 26-29 have been amended to be directed to a program product that is stored in one or more tangible computer readable media and readable by a computer rather. Further, claim 26 recites signals that are applied to funds, a funded account, and a provider account, which are physical articles and therefore statutory subject matter. Therefore, the claims are directed toward a physical object or machine and thereby satisfy *Gottschalk v. Benson*, 49 U.S. 63, 71-72 (1972).

Support for these amendments may be found at [0004] as well as original claims 17, 28, 30, and 32. It is believed that no new matter has been added by the amendments. The Applicant submits that the amendments to claims 26-29 overcome the rejection under 35 U.S.C. §101. Reconsideration is respectfully requested.

**As per claim 31**, the Examiner asserts that although the claim recites a computer, the acts performed by the computer only manipulate signals which are not any of a process, machine, manufacture, or compositions of matter, thus, the acts are not being applied to statutory subject matter. Claim 31 has been amended such that the recited signals positively manipulate funds within a funded account and a provider account, which are physical articles and therefore statutory subject matter under *Gottschalk v. Benson*.

Support for these amendments may be found at [0004] as well as original claims 17, 30, and 32. It is believed that no new matter has been added by the amendments. The Applicant submits that the amendments to claim 31 overcome the rejection under 35 U.S.C. § 101. Reconsideration is respectfully requested.

Although the Examiner rejected claim 17 when rejecting claims 1-33 under 35 U.S.C. § 101, the Examiner did not provide a reason as to why claim 17 was rejected. The Applicant presents that claim 17 satisfies 35 U.S.C. § 101 and that the rejection should be reversed. Reconsideration is respectfully requested.

The foregoing is believed to be a comprehensive and effective response to the rejections of claims 1-33 under 35 U.S.C. § 101 set forth in the most recent Office Action. The application is therefore believed to be in condition for allowance and an early allowance is respectfully requested.

### **35 U.S.C. §102**

**Claims 1-33** are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication 2003/0200118 A1 to Lee et al. (hereinafter *Lee*).

**As per claim 1** (and the currently pending claims dependent therefrom), the Examiner asserts that *Lee* discloses a healthcare claims management and payment transaction system comprising a registration mechanism, a claim submission mechanism and a claim processing mechanism. Further, the Examiner asserts as per claim 6 that *Lee* discloses wherein the payment authorization is based in part on the claim information as compared to one or more templates and/or rule sets ("TPN is developing a 'Privacy and Security Policy' whose goal is 'to keep health care claim payment financial information secure and confidential.' While the Policy is still under development, the TPN hPay Solution System must support the Policy's Objectives and must comply and conform with all the Rules and Regulations." *Lee* at [0380]. It is noted that the claim limitations of claims 6 and 7 are now incorporated into claim 1 per the present amendment.

The templates and rule sets, as defined by paragraphs [0010], and [0016] - [0018], are developed such that claims relating to the employer, the healthcare provider, insurance provider or healthcare plan administrator may be compared thereto. The templates and rule sets may include treatment codes and payment rates. More specifically, the templates and rule sets may set applicable rates for services and expenses claimed. If the compared claim information does not comply with the applicable templates or rules sets, a message may be generated and transmitted to some or all of the users of the system.

The "Privacy and Security Policy" of *Lee* cited by the Examiner appears to be directed to an entirely different purpose than the templates and rules sets as defined in the present application. Although it is not clear from *Lee* as to what the "Privacy and Security Policy" is directed toward because it is still "under development," it appears that it is to safeguard data that is transferred to and from the system. The Policy is described under a heading that reads "Users must be authenticated" [0378], which further implies that the Policy is directed toward data

security and authentication. This is not the same as the templates and rule sets as defined in the present application. For example, the "Privacy and Security Policy" is completely silent as to setting applicable rates for services and expenses claimed as well as also comparing claim information to templates or rule sets. The templates and rule sets of the present application are not specifically dedicated to securing data.

Additionally, the Applicant presents that *Lee* is not enabling as to the disclosed "Privacy and Security Policy." The reference itself indicates that the Policy is still "under development." *Lee* at [0380]. "The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." MPEP §2121.01 (citing *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003)). Therefore, *Lee* does not teach, suggest or disclose templates, rule sets or a combination thereof.

Further, amended claim 1 requires that the claim processing mechanism be constructed and arranged to calculate and append to the claim information rates corresponding to services, expenses or combinations thereof. Embodiments of the present application automatically calculate rates based on the services and/or expenses of the healthcare claim. Conversely, the system disclosed by *Lee* requires that a member of the provider's staff estimate an amount for which the patient will be responsible. *Lee*, at [0021]. As such, *Lee* does not teach, disclose or suggest a claim processing mechanism that is constructed and arranged to calculate and append to the claim information rates corresponding to services, expenses, or combinations thereof provided by the claim information. The Applicant requests review of claim 1 and the currently pending dependent claims in view of the above arguments.

**As per claim 10** (and the currently pending claims dependent therefrom) the Examiner similarly asserts that *Lee* discloses, *inter alia*, a method comprising steps performed by a registration mechanism, a claim submission mechanism and a claim processing mechanism. It is noted that the claim limitations of claims 13 and 15 have been incorporated into claim 10 by the present amendment. The Applicant, however, disagrees with the Examiner's conclusions based upon *Lee*, and therefore requests review of claims 10 and the currently pending dependent claims in view of the arguments regarding claim 1 provided herein above.

**As per claim 17**, the Examiner asserts, *inter alia*, that *Lee* discloses a payment authorization being based at least on the registration information, the claim information and one or more templates and/or rule sets (see the "Privacy and Security Policy" text at [0380] of *Lee*). The Applicant disagrees with this assertion for the reasons cited herein above (i.e., the "Privacy and Security Policy" of *Lee* is not enabling and does not teach, suggest or disclose templates, rule sets, or combinations thereof). The Applicant therefore requests review of claim 17 accordingly.

**As per claim 26** (and the currently pending claims dependent therefrom), the Examiner asserts that *Lee* discloses an apparatus for managing, processing and paying healthcare claims. Per the amendment herein above, claim 26 has been amended to recite a program product for managing, processing and paying healthcare claims. It is noted that the claim limitations of claim 28 have been incorporated into claim 26 by the present amendment. The Applicant disagrees with the Examiner's conclusions based upon *Lee*, and therefore requests review of claims 26 and the currently pending dependent claims in view of the arguments regarding claim 1 provided herein above.

**As per claim 31** (and currently pending claim 33), the Examiner asserts that *Lee* discloses at least one computer programmed to execute a process for managing, processing and paying claims. It is noted that the claim limitations of claim 32 have been incorporated into claim 31 by the present amendment. The Applicant disagrees with the Examiner's conclusions based upon *Lee*, and therefore requests review of claims 31 and 33 in view of the arguments regarding claim 1 provided herein above.

Hence, the Applicant asserts that the rejections of claims 1-33 under 35 U.S.C. §102(e) as being anticipated by *Lee* are overcome. Reconsideration is respectfully requested.

## Conclusion

The foregoing is believed to be a comprehensive and effective response to the rejections under 35 U.S.C. §§ 112, 101 and 102 set forth in the most recent Office Action. The application is therefore believed to be in condition for allowance and an early allowance is respectfully requested. However, Applicant invites the Examiner to contact their counsel at the number or e-mail listed below in the event there remains any unresolved issues which may be efficiently addressed.

Respectfully submitted,

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